

Remarks

The first paragraph of the specification has been amended to include the patent number of the parent application as requested by the Examiner. Applicant has also included herewith a Form 1449 with the complete citation of the Aria *et al.* reference as well as an additional copy of this reference. Applicant requests that the Examiner initial the Form 1449 as an indication that reference has been considered and return the initialed Form 1449 with the next communication.

Claims 1-3, 6-9, 12-22, 27, 30-32, 65, 68, 71, 72, and 75 are pending in the above-referenced application. The Examiner has rejected claims 1-3, 6-9, 12-22, 27, 30-32, 65, 68, 71, 72, and 75.

All pending claims 1-3, 6-9, 12-22, 27, 30-32, 65, 68, 71, 72, and 75 have been canceled herewith, and new claims 83-142 are added. Support for the new claims can be found throughout the application as originally filed. Specifically, claims 83-142 find support in original claims 1-3, 6-9, 12-22, 27, 30-32, 65, 68, 71, 72, and 75 and in the specification in paragraphs [0025]-[0044], [0051]-[0058], [0063]-[0100], [0114]-[0137], [0212]-[0233]. Applicant respectfully submits that no new matter is presented with these amendments. Additionally, the terms in the new claims have been defined in the claims. Definitions for these terms can be found in the specification in paragraphs [0159]-[0173].

Applicant reserves the right to prosecute without prejudice in a future application subject matter amended or canceled from the claims by the Amendment submitted herewith. Applicant respectfully requests reexamination and reconsideration of the case, as amended. Although the rejections have been rendered moot by cancellation of claims 1-3, 6-9, 12-22, 27, 30-32, 65, 68, 71, 72, and 75, each of the rejections levied in the Office Action is addressed individually below as it pertains to the new claims.

I. Obviousness-type Double Patenting. The Examiner has rejected claims 1-3, 6-9, 12-22, 27, 30-32, 65, 68, 71, 72, and 75 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 33 of U.S. Patent 6,348,467 (Corey). Applicant submits that this rejection is rendered moot by the present Amendment. Claims 1-3, 6-9, 12-22, 27, 30-32, 65, 68, 71, 72, and 75 have been canceled and replaced with claims 83-142. The pending claims as amended are patentably distinct from claims 1 and 33 of the '467

patent.

II. Rejection under 35 U.S.C. § 112, second paragraph, for indefiniteness. The Examiner has rejected claims 1-3, 12-20, 30-32, 65, 72, and 75 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant submits that the present Amendment renders moot this rejection.

III. Rejection under 35 U.S.C. § 102 or 35 U.S.C. § 103(a), as being unpatentable over Danishefsky et al. (U.S. Patent 6,686,470) or Corey (U.S. Patent 6,348,467). Original claims 1-3, 6-9 12-22, 27, 30-32, 65, 68, 71, 72, and 75 were rejected under 35 U.S.C. § 102 as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious in light of Danishefsky et al. (U.S. Patent 6,686,470) or Corey (U.S. Patent 6,348,467). The present Amendment renders moot this rejection. The present claims are not anticipated by Danishefsky et al. or Corey since the compounds disclosed by Danishefsky et al. and Corey have m being 1 and a methylene-dioxy group joining together X₁ and R₇ of formula (I) of the present application. Such compounds are not encompassed by the pending claims. Therefore, Applicant requests that the rejection be removed.

In addition, the claimed invention is not rendered obvious by Danishefsky et al. or Corey given the disclosure of only ecteinascidin-like compounds in both these references. The Examiner has provided no additional teaching to suggest modifying these references along the lines of the present invention. Obviousness requires that there be a teaching in the art to make the modifications in the invention. Without such a teaching, the Examiner has not established a *prima facie* case of obviousness. Therefore, Applicant requests that the rejection be withdrawn.

IV. Rejection under 35 U.S.C. § 102 or 35 U.S.C. § 103(a), as being unpatentable over Zhou et al., Saito et al., Kobo et al., and Frincke et al. Original claims 1-3, 6-9 12-22, 27, 30-32, 65, 68, 71, 72, and 75 were rejected under 35 U.S.C. § 102 as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as rendered obvious by Zhou et al., Saito et al., Kobo et al., or Frincke et al. The present Amendment renders moot this rejection. The present claims are

not anticipated by any of the cited references. The various compounds disclosed in these references are not encompassed by the pending claims. Therefore, Applicant requests that the rejection be removed.

In addition, the claimed invention is not rendered obvious by any of these references given the differences between the claimed invention and the disclosed compounds in these references. The Examiner has provided no additional teaching to suggest modifying these references along the lines of the present invention. Without a teaching to make these modifications, the Examiner has not established a *prima facie* case of obviousness. Therefore, Applicant requests that the rejection be withdrawn.

In view of the forgoing amendments and remarks, Applicant respectfully submits that the present case is now in condition for allowance. A Notice to that effect is requested.

If it is believed that a telephone conversation would expedite matters, the Examiner is invited to contact the undersigned at (617) 248-5215. Although it is believed that there is no fee associated with this amendment, if Applicant is mistaken, please charge any fees to our Deposit Account Number: 03-1721.

Respectfully Submitted,


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